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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

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IN RE APPLICATION OF :  
ISABELLE AFRIAT : EXAMINER: WELLS  
SERIAL NO: 09/884,949 :  
FILED: JUNE 21, 2001 : GROUP ART UNIT: 1617  
FOR: COMPOSITION IN THE FORM OF A  
WATER-IN-OIL EMULSION WITH  
A VARIABLE SHEAR RATE AND  
METHODS OF USING THE SAME

REQUEST FOR RECONSIDERATION

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

SIR:

In response to the Office Action mailed October 8, 2002, and the Advisory Action mailed March 26, 2003, Applicant respectfully requests reconsideration of the present application in view of the following remarks.

The Office Action dated October 8, 2002, rejected claims 1-22 and 25-29 under 35 U.S.C. § 103 as obvious over U.S. patent 5,851,539 ("Mellul"), and claims 23 and 24 under 35 U.S.C. § 103 as obvious over Mellul in view of The Condensed Chemical Dictionary.

Applicant filed a Request for Reconsideration on March 10, 2003, focusing on the improved rheological characteristics of the claimed W/O emulsions (having 80% or more aqueous phase) related to their ability to "break" more readily than W/O emulsions containing less aqueous phase-(70% aqueous phase), leading to better fluidization properties and, hence, greater freshness upon application to skin than emulsions containing prior art

amounts of aqueous phase, a “surprising and unexpected difference” between these emulsions.

The Advisory Action dated March 26, 2003, affirmed the outstanding rejections, stating that Applicant’s arguments concerning the claimed W/O emulsions’ improved rheological properties were not persuasive because Applicant’s showing related to such properties was not commensurate in scope with the claims. Specifically, the Advisory Action stated that Applicant’s showing was too narrow in scope in two respects: (1) Applicant provided only one example of a W/O emulsion containing 80% or greater aqueous phase; and (2) the claimed compositions did not break when shear stress of 100-349 Pa is applied.

In view of the following comments, Applicant respectfully submits that the claims are commensurate in scope with Applicant’s showing and, accordingly, requests that the § 103 rejections be withdrawn.

Regarding (1), Applicant notes that Mme. Chevalier’s July 24, 2002 declaration demonstrates that compositions containing aqueous phases of 80.5% (example 1), 79.83% (CM 3/1) and 86.55% (CM 3/2) readily break. Moreover, in a new Rule 132 declaration to be filed within the week, Mme. Chevalier reports that W/O emulsions containing aqueous phases of 89.5% (658463-2) and 90.55% (658463-3) readily break as well. Thus, Applicant has demonstrated that several W/O emulsions containing a wide variety of aqueous phase contents readily break and, thus, possess improved rheological properties. Accordingly, Applicant respectfully submits that her showing of improved rheological characteristics for the claimed emulsions is commensurate in scope with the pending claims.

Regarding (2), the fact that the W/O emulsions discussed in Mme. Chevalier’s previous Rule 132 declaration did not readily break at shear rates of 1-349 Pa does not lead to the conclusion that the claims are not commensurate in scope with Applicant’s showing. As

previously indicated, shear stress forces to which W/O emulsions are typically subject upon application to skin range from 100-1000 Pa. What is important for purposes of “breaking” is that the emulsion breaks at some point in the 100-1000 Pa range, not that it break throughout the entire range. As explained in Mme. Chevalier’s new Rule 132 declaration, the significant point from the experimental data discussed in her Rule 132 declarations is that the claimed W/O emulsions readily break when applied to skin at shear stress forces to which W/O emulsions are typically subject upon such application (100-1000 Pa), whereas comparative examples do not. Thus, the Advisory Action’s focus on the 1-349 Pa range is misplaced. In view of the above, Applicant respectfully submits that her showing of improved rheological properties is commensurate in scope with the claims.

In addition to having improved rheological properties, the claimed compositions, despite their high water content, are stable even when stored under conditions of fluctuating temperatures. (Page 3, lines 19-21). The examples in the present specification demonstrate that the claimed compositions possess good stability under such conditions, whereas comparative compositions do not.

Applicant submits that the improved rheological and physical characteristics of the claimed compositions as set forth and explained in all of the submitted Rule 132 declarations, as well as the compositions’ improved stability under fluctuating temperature conditions, demonstrate that the claimed compositions are not obvious and, thus, deserving of patent protection.

Thus, even assuming *arguendo* that the Office Action has established a *prima facie* case of obviousness --which it has not<sup>1</sup>-- the Rule 132 declarations submitted in this case and

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<sup>1</sup> Applicant’s July 24, 2002, response sets forth the reasons why no *prima facie* case of obviousness has been established. For sake of brevity, Applicant will not repeat these arguments herein.

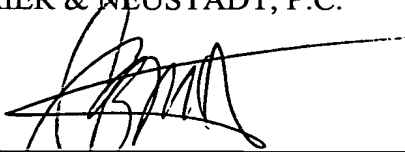
the examples in the specification are more than sufficient to overcome such a hypothetical *prima facie* showing. The declarations demonstrate that W/O emulsions containing 80% or more aqueous phase “unexpectedly and surprisingly” break more readily than emulsions containing less aqueous phase, meaning that the former compositions have more aqueous phase available for contact with skin than the latter emulsions. The declarations indicate that this difference is significant because it provides W/O emulsions having 80% or more aqueous phase a fresher feeling upon application, an important characteristic in the cosmetic field. The declarations also demonstrate that compositions corresponding to Mellul’s Example 24 are unsuitable for use in the cosmetic industry, unlike the claimed invention. Finally, the examples in the present specification demonstrate that compositions containing the claimed silicone surfactant are more stable under fluctuating temperature conditions than compositions containing other silicone surfactants, making the former compositions better suited for commercial production, storage and transport than the latter compositions.

In view of the above, Applicant respectfully requests that the rejections under 35 U.S.C. §103 be withdrawn.

Applicant believes that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
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